

Commissioner for Patents
Amendment dated October 22, 2004
Response to Office Action dated July 22, 2004
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Art Unit: 3632
Examiner: Sterling
Docket No. RPS9 2003 0080 USI

REMARKS/ARGUMENTS

Claims 1-20 were presented and examined. With respect to a previously issued restriction requirement, the Examiner required affirmation of Applicant's provisional election. The Examiner rejected claims 9-11, 14, and 15 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner rejected claims 9-11, 14, and 15 under 35 USC § 112, second paragraph, as indefinite. Claims 1-3, 9-11, 14, and 18-20 were rejected under 35 USC § 102(b), as being anticipated by Lindsay (U.S. Patent No. 5,697,757), hereinafter "Lindsay". The Examiner rejected claims 6 and 15 under 35 USC § 103(a), as being unpatentable over Lindsay in view of Stenkvist *et al.* (U.S. Patent No. 6,334,595), hereinafter "Stenkvist". In this response, Applicant has canceled claims 1, 4, 5, 7, 8, 12, 13, 16, and 17, amended claims 2, 3, 6, 9, and 18, and added claim 21. Claims 2, 3, 6, 7, 9-11, 14, 15, and 18-21 remain pending.

Elections/Restrictions

Applicant, by and through the undersigned representative, hereby affirms its election, without traverse, to prosecute the invention of Species I, Figs. 4A, 4B, claims 1-3, 6, 9-11, 14, 15, and 18-20. Applicant hereby cancels withdrawn claims 4, 5, 7, 8, 12, 13, 16, and 17 without waiver of or prejudice to the subject matter of the unelected claims.

Claim rejections under 35 USC § 112, second paragraph

The Examiner rejected claims 9-11, 14, and 15 under 35 USC § 112, second paragraph, as indefinite. In response, Applicant submits that has amended claim 9 to correct the clear error in the originally submitted claim that resulted in the antecedent basis problem Section 112 issue. Specifically, although it is clear from the drawings and specification that the free end of the extension link rotates about the pivot point, claim 9 as originally submitted recited that the extension link rotated about the link pin. Applicant has amended the claim to recite that the free end of the extension link rotates about the pivot point. Applicant believes that claim 9 as amended is fully compliant with the requirements of Section 112, second paragraph. Accordingly, Applicant would respectfully request the Examiner to reconsider and withdraw the Section 112, second paragraph rejection.

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Claim rejections under 35 USC § 112, first paragraph

The Examiner rejected claims 9-11, 14, and 15 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. In response, Applicant submits that the amendment, discussed above, made to address the Section 112, second paragraph issue renders the Section 112, first paragraph issue moot. Accordingly, Applicant would respectfully request the Examiner to withdraw the Section 112, first paragraph rejection.

Claim rejections under 35 USC §§ 102(b), 103(a)

The Examiner rejected claims 1-3, 9-11, 14, and 18-20 under Section 102(b) as being anticipated by Lindsay.

In response to the rejection of independent claim 1, Applicant has canceled claim 1 and rewritten previously submitted claim 3 in independent form incorporating the limitations of claim 1 as originally presented. Claim 3 recites a yoke having a second slot perpendicular to the first slot and a pin attached to a fixed reference through the second slot. The Office Action rejected claim 3 as originally presented, indicating that Lindsay discloses "a pin (37) attached to a fixed reference through the second slot to guide the motion of the yoke as it translates."

Applicant respectfully traverses the rejection of claim 3 because the cited referenced does not disclose all of the claim limitations. Specifically, Lindsay does not disclose all of the claim limitations because element (37) of Lindsay is not a pin attached to a fixed reference through the second slot to guide the motion of the yoke as it translates. Element 37 of Lindsay is a wheel that enables the Lindsay carriage/trolley (36) to translate within the second slot.

A rolling wheel is not a "pin attached to a fixed reference." The Office Action did not indicate what feature or element of Lindsay corresponds to the claim language "attached to a fixed reference." Applicant would respectfully submit that the wheel (37) of Lindsay is not attached to a fixed reference at all, but, to the contrary, is specifically designed and required to be not attached to a fixed reference. If the wheels 37 of Lindsay could not roll freely, the Lindsay carriage/trolley 36 would not be able to translate and the invention would not be functional because the telescopic arm 10 would not be able to rotate about axis 29.

A Section 102(b) rejection is proper only when the cited reference discloses all of the claim limitations. Because Lindsay does not disclose all of the limitations of claim 3, Applicant

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would respectfully request the Examiner to reconsider and withdraw the claim 3 anticipation rejection. By their dependency on claim 3, claims 2, 6, and 21 are also believed to recite limitations not found in the cited reference.

With respect to independent claim 9, Applicant has amended to recite that the mechanical arm is free to rotate 360 degrees about the pivot point. Because support for this amendment is found in the specification as filed in the paragraph beginning on page 5, line 4, no new matter is presented by this amendment. Applicant respectfully submits that the cited reference does not disclose or suggest a mechanical arm free to rotate 360 degrees about a pivot point.

The mechanical arm 10 of Lindsay is clearly unable to rotate 360 degrees about axis 29. The configuration of guideway 35 limits the arc through which arm 10 could rotate to a maximum of 180 degrees. Specifically, because trolley 36 is prevented from moving to the left of axis 20 (from the perspective of FIG. 1 of Lindsay), arm 10 is restricted to an arc of 180 degrees. Because the cited reference does not teach the limitations of claim 9 as amended, Applicant would respectfully request the Examiner to reconsider and withdraw the anticipation rejection of claim 9 and its dependent claims (claims 10, 11, 14, 15, and 22).

Independent claim 18 has been amended to include a limitation analogous to the limitation added to claim 9. For reasons analogous to those presented above with respect to claim 9, Applicant would respectfully request the Examiner to reconsider and withdraw the anticipation rejection of claim 18 and its dependent claims (claim 19 and 20).

In addition to the foregoing, Applicant has added new claim 21. Claim 21 recites the invention of claim 3 where the counterbalance link rotates about a pin on one side of the fixed reference while the arm rotates about the pin on a second side of the fixed reference. Support for this claim element is found in the specification at the paragraph beginning on page 5 line 4. The element recited in claim 21 provides a means by which the extension link and the arm are displaced from one another so that their respective planes of rotation are also displaced from one another. Because Lindsay describes an integral telescopic arm in which one portion of the Lindsay arm is analogous to Applicant's extension link while another portion of the Lindsay arm is analogous to Applicant's arm, Lindsay would not be able to accommodate displacement of the extension portion of the arm with respect to the remaining portion of the arm. The telescoping feature of Lindsay requires that the extension portion of the arm communicate with the remaining

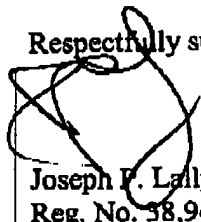
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arm portion and that the two portion rotate in a common plane of rotation. Accordingly, Applicant believes that the limitations recited in claim 21 are not disclosed or suggested in the cited references.

In this response, Applicant has addressed the Examiner's election/restriction requirement, claim rejections under 35 USC § 112, first paragraph, 35 USC § 112, second paragraph, 35 USC § 102(b), and 35 USC § 103(a). Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request the Examiner to withdraw the rejections, allow the pending claims, and advance the application to issue. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.428.9872.

Respectfully submitted,



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